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# PATENT COOPERATION TREATY

## PCT



### INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference Central	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/PT 03/00013	International filing date (day/month/year) 01.10.2003	Priority date (day/month/year) 02.10.2002
International Patent Classification (IPC) or both national classification and IPC H04Q7/26		
Applicant ROSADO, Teresa Maria de Andrade		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 7 sheets, including this cover sheet.  
  
☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).  
  
 These annexes consist of a total of 31 sheets.

3. This report contains indications relating to the following items:
  - I ☒ Basis of the opinion
  - II ☐ Priority
  - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
  - IV ☐ Lack of unity of invention
  - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
  - VI ☐ Certain documents cited
  - VII ☐ Certain defects in the international application
  - VIII ☐ Certain observations on the international application

Date of submission of the demand  27.04.2004	Date of completion of this report  13.12.2004
Name and mailing address of the international preliminary examining authority:   European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer  Grimaldo, M  Telephone No. +49 89 2399-7513  

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EXAMINATION REPORT**

International application No. **PCT/PT 03/00013**

**I. Basis of the report**

1. With regard to the elements of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

**Description, Pages**

1-21 filed with telefax on 07.10.2004

**Claims, Numbers**

1-25 filed with telefax on 07.10.2004

**Drawings, Sheets**

1/6-6/6 filed with telefax on 07.10.2004

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:
- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.
4. The amendments have resulted in the cancellation of:
- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

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5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

Novelty (N)	Yes: Claims	2-25
	No: Claims	1
Inventive step (IS)	Yes: Claims	
	No: Claims	1-25
Industrial applicability (IA)	Yes: Claims	1-25
	No: Claims	

**2. Citations and explanations**

**see separate sheet**

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**Cited documents**

The following documents (D) are cited in the search report; the numbering will be adhered to throughout the procedure:

D1: US 2002/019246 A1 (FORTE STEPHEN P) 14 February 2002  
D2: FR-A-2 776 883 (ALSTHOM CGE ALCATEL) 1 October 1999

**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement**

1. The amended claim 1 filed with the International Bureau under Article 19(1) introduces subject-matter which extends beyond the content of the application as filed, contrary to Article 19(2) PCT. The statement concerned is the following:  
"without needing to access fixed networks of the following type: PSTN, ISDN, IP or direct lines".  
Applicant should have deleted the statement or replaced it with subject-matter belonging to the application as originally filed.
- 2.1 The aim of amended claim 1 is to give to a mobile phone all PABX extension proprieties: the all PABX services are available at the mobile phone independently of the configuration of the programmable mobile phone used.  
However, this feature is claimed in the formulation of claim 1 merely an aim to be achieved: "system...allows any programmable mobile phone... accessing all services of the referred PABX as internal extension of the referred PABX", and more, "the communication's transmission line... established... without needing to access fixed networks".  
The present formulation of claim 1 seeks to replace the technical features by referring to features which concern the effect which it is desired to achieve (Article 6 PCT).  
The technical features necessary for achieving this result should have been added.
- 2.2 Moreover, the features of the apparatus claim 1 (a communication system) relate more to a method of using the apparatus rather than clearly defining the system in terms of its technical features. The intended limitations are therefore not clear

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from this claim, contrary to the requirements of Article 6 PCT. It is the apparatuses/means of the communication system that allow a programmable mobile phone to access all the services of a PABX that should be found in the formulation of the claim.

- 2.3 Since the formulation of claim 1 is unclear and lacks of technical features its subject-matter can be read into document D1 which discloses a communication system between a mobile phone and a PABX (paragraph 0007) allowing a mobile phone to connect, communicate, making and receiving phone calls as PABX extension (paragraph 0026).

It is therefore considered that the subject-matter of independent claim 1 is already known from document D1 and the subject-matter of claim 1 lacks novelty in the sense of Article 33(1) and 33(2) PCT.

- 2.4 The same objection of lack of novelty caused by lack of technical features in the formulation of claim 1 can be raised starting from document D2, see page 1, line 23 - page 3, line 11, page 5, line 18 - page 7, line 17, claim 1 and figure 1.

- 3.1 Claims 2-25 do not contain any features which, in combination with the features of any of the claims upon which they are dependent, would lead to a claim involving inventive activity (Article 33(3) of the PCT).

Their subject-matter is indeed either derivable from the above-cited documents or concerns simple embodiments without any inventive merit in themselves.

In particular:

- 3.2 Claim 2 is directly derivable from document D2 on page 1, lines 9-17.  
3.3 Claim 8 is directly derivable from document D1 on paragraphs 0025-0027.  
3.4 Claim 17 is directly derivable from document D1 on paragraphs 0035.  
3.5 Claim 18 specifies the use of the system of claims 1-17 which has been proved not being neither new nor inventive, in a PABX, and as a consequence does not fulfill the requirement of Article 33(1) and 33(3) of the PCT.  
3.6 Claim 20 specifies a software integrated in the PABX CPU realizing the functions of claim 17 which has been proved not being inventive (Article 33(3) PCT).

**Certain defects in the international application**

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4. To meet the requirements of Rule 6.3(b) PCT, the independent claims should have been properly cast in the two-part form, with those features which in combination are part of the prior art (see document D1 or D2), being placed in the preamble.
5. To meet the requirements of Rule 5.1(a)(ii) PCT, document D2 should have been identified in the description and the relevant background art disclosed therein should have been briefly discussed.

**Certain observations on the international application**

6. Claims 2, 10, 11 and 12 are not clear (Article 6 PCT) since the expression "...and other/s" is not defining a concrete communication system.
7. The same objection of paragraph 10 applies for the expression "other frequencies allowed ...." of claim 4.
8. The same objection of paragraph 10 applies for the expression "according to the country's law at the moment of the communication" of claim 10.
9. Claims 20-25 lack clarity with regard to their category.  
According to the PCT only two basic kinds of claims exist, viz, claims to a physical entity (apparatus) and claims to an activity (process) (cf. PCT Guidelines C-III, 3.1). As a consequence, a claim for a "software integrated in the PABX CPU" (method claim) should only contain process features as opposed to structural features.

The clarity of claims is of the utmost importance in view of their function in defining the matter for which protection is sought. In view of the differences in the scope of protection which may be attached to the various categories of claims, the wording of a claim should leave no doubt as to its category (Article 6 PCT and PCT Guidelines C-III, 4.1).

Claims related to a method (claims 20-25) should therefore be written as claims having only functional means without referring to claims of an apparatus category (claims 1-19).

Claims 20-25 should have therefore been amended in such a way so that they are clearly in the method category.

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10. Claim 25 may not refer, in particular with expressions such as "as illustrated in attached figures", to the drawings (Article 6 PCT in combination with Rule 6.2 PCT). Claim 25 should have been deleted.